

Claim Status

Claims 1-20 were originally filed in this application. Currently pending for examination are claims 1-20, which are finally rejected in paper no. 11, mailed 2/28/2003.

PRIORITY

The Office Action (paper no. 11, mailed 2/28/2003, paragraph no. 1, denies Applicant's claim for priority to Provisional Application 60/201,556, because allegedly "the provisional application does not provide a specification disclosing the claimed invention, therefore there is no support for the claimed invention." Applicants respectfully disagree with this position. Applicants have enclosed as "Appendix A", Provisional Application Serial No. 60/201,556 for which priority is sought.

MPEP 601 provides guidelines for drafting a provisional application 35 U.S.C. 111(b) mandates the contents of a provisional application specification. 35 U.S.C. 111(b) mandates that a provisional application shall comply with the first paragraph of 35 U.S.C. 112 and include a drawing if necessary. A claim is not required. It is the position of Applicant that the provisional application as filed does provide support for the invention as claimed. Provisional Application Serial No. 60/201,556 contains 28 pages of text, about 42 Figures and 6 Tables of the glass compositions claimed in the instant application. The Specification is a compilation of six different peer-reviewed publications directly concerning the subject matter in the instant application. Note: the six different publications are not about similar work, or used to support arcane points of science, but the six different works are directly related to the invention claimed in the instant

application. There is nothing wrong or improper with this specification. It is recognized by Applicant that the above does not conclusively settle the issue of the priority denial.

Restated, the issue is whether 60/201,556 complies with 35 U.S.C. 112, first paragraph, i.e. is the invention claimed in the instant invention described in the specification. Applicants respectfully assert that it is. The Office Action points to no specific limitation in the claims of the instant invention not found in 60/201,556. Applicant's are not required, *absent more support for the Office Action's position*, to review on record, claim limitation by claim limitation and point to where in the provisional application there is support. However, in support of Applicant's, the claim 1 glass composition limitation is examined to show support. The glass composition found in claim 1, that is: "about 44.2 to about 67.7 wt % SiO₂, about 10.1 to about 23.4 wt % CaO, about 5.7 to about 13.3 wt % MgO, about 8.3 to about 23.6 wt % Na₂O, about 2.2 to about 6.5 wt % K₂O and about 6.0 wt % P₂O₅". Each compound and its quantity are specifically disclosed on Page 1, Table 1 of the provisional application specification. A review of the ranges will bear this out.

If the Office has other concerns about specific claim limitations, Applicant respectfully requests that they be made of record and Applicant given a proper chance to respond. Accordingly, it is respectfully requested that the denial or priority be removed.

CLAIM REJECTIONS

Claim Rejections- 35 USC § 102

Claims 1-19 have been rejected under 35U.S.C. 102(b) as allegedly being unpatentable over Bioceramics: Materials and Applications article titled "Glass-

Hydroxyapatite coatings on titanium-based implants" allegedly published in December 1999.

Applicants respectfully traverse this rejection. The publication referred to in the Office Action was actually published on 2/23/2002, thus it is not prior art under 35 U.S.C. 102(b). Evidence of this publication is included herewith in "Appendix B", and it is a letter from the Publisher, The American Ceramic Society. The letter states that "the first books being mailed to customers on 2/23/2000.

Withdrawal of the rejection is respectfully requested.

Claim Rejections- 35 USC § 103

Claim 20 has been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Bioceramics: Materials and Applications article titled "Glass-Hydroxyapatite coatings on titanium-based implants" allegedly published in December 1999. Applicants respectfully traverse this rejection. As, explained above, the reference is not anticipatory under 35 U.S.C.102(b), and therefore this rejection must fail.

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CONCLUSION

Having overcome all rejections, Applicants respectfully requests that a timely Notice of Allowance be issued in this application. If a telephone conversation will expedite the prosecution of this application, the Examiner is kindly invited to call Applicant's representative at the telephone number listed below.

All fees believed due have been submitted. If Applicant is wrong in this assumption, the PTO is authorized to charge any deficiency to Applicant's account number 120690. The PTO is not authorized to charge the issue fee to this account.

Respectfully Submitted,



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Enclosure: Appendix A: Provisional Serial No. 60/201,556
Appendix B: Letter from The American Ceramic Society